



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,194	07/19/2001	Michael A. Wilkman	HOLCORP.005A	9144
20995	7590	09/12/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			CHAMPAGNE, DONALD	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3622	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,194

Applicant(s)

WILKMAN, MICHAEL A.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-13,15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-13, 15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 May 2006 has been entered.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US005644723A).
5. Meyer et al. teaches (independent claim 8) a method for managing promotions, comprising:
receiving, via an electronic communications medium, a plurality of promotions relating to a plurality of merchants (col. 9 lines 56-59 and col. 1 line 29);
receiving, via an electronic communications medium, user information relating to a plurality of *members/users*, wherein the *member/user* information includes *member/user*

Art Unit: 3622

account information (col. 8 lines 12-19, col. 33 lines 30-39, including Fig. 27, and col. 34 lines 16-28);

matching at least one of the plurality of promotions to at least one of the plurality of *members/users* based at least upon a portion of the plurality of *member/user* information and user account information (col. 46 lines 26-42); and

presenting to at least one of the plurality of *members/users*, via a personal computer device (col. 7 lines 55-57), information in a promotion document about the at least one of the plurality of promotions (col. 6 lines 34-43).

6. Meyer et al. also teaches at the citations given above claim 11. Meyer et al. also teaches claim 9 (col. 8 line 39) and claim 10 (col. 3 line 46 and col. 53 lines 35-43).
7. Claim 19 is rejected under 35 U.S.C. 103(a) as obvious over Meyer et al. in view of Hoffman et al. (US006397198B1). Meyer et al. does not teach user accounts configured to transfer funds. Hoffman et al. teaches user accounts configured to transfer funds (col. 3 line 63 to col. 4 line 2). Because the tokenless account access control system of Hoffman et al. further promotes commerce (col. 1 lines 25-33 and 56-60, and col. 2 lines 24-35), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Hoffman et al. to those of Meyer et al.
8. Claims 1-6, 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman et al. in view of Meyer et al.
9. Hoffman et al. teaches (independent claim 1) a system for facilitating the matching of at least one promotion with at least one user, the system comprising:
 - a merchant management module (*rewards transaction processor*) configured to manage, via an electronic communications medium, at least one promotion (*rewards*) that corresponds to at least one of a plurality of merchants (*various reward-units issuers*, col. 4 lines 28-34);
 - a personal computer device (*terminal 4*) configured to manage preferences, wherein the personal computer device is further configured to manage a plurality of user accounts for transferring funds (col. 4 line 45 to col. 5 line 9, including Fig. 1, and col. 5 lines 27-31); and

a transaction module (*execution module 28*) configured to present information about the at least one promotion to at least one user via the personal computer device (col. 3 line 58 to col. 4 line 2), the transaction module further configured to select at least one of the plurality of user accounts to use for a commercial transaction with the at least one of a plurality of merchants (col. 6 lines 15-21 and col. 7 lines 37-58).

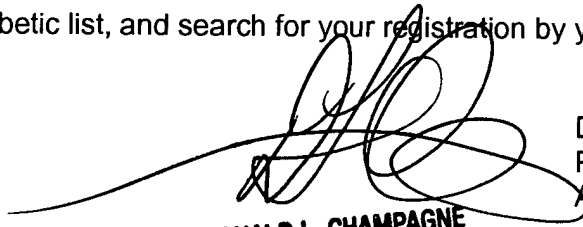
10. Hoffman et al. does not teach that the selection is based at least in part on the at least one promotion. However, Hoffman et al. does teach that the account is selected by the user (col. 8 lines 31-39). Hence it would have been obvious for the user to make the selection based at least in part on the at least one promotion if there is any benefit to doing so (i.e., a special reward).
11. Hoffman et al. does not teach that the promotion relates to preferences that correspond to the user. Meyer et al. teaches that the promotion relates to preferences that correspond to the user (col. 6 lines 34-43 and col. 8 lines 31-37). Because Meyer et al. teaches that it is efficient to select promotions that relate user preferences (*interests and past purchasing behavior*, col. 1 lines 36-44 and 54-55), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Meyer et al. to those of Hoffman et al.
12. Hoffman et al. also teaches at the citations given above claims 4 and 12. Hoffman et al. also teaches claim 5 (col. 7 lines 59-62), claim 13 (col. 3 line 63 to col. 4 line 2) and claim 15 (col. 8 lines 37-39).
13. Meyer et al. also teaches at the citations given above claim 6. Meyer et al. also teaches claim 2 (col. 9 lines 56-59 and col. 1 line 29) and claim 3 (col. 8 lines 12-19 and col. 34 lines 16-28).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 8:30 AM to 7 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

Art Unit: 3622

15. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
17. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

5 September 2006